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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/788,162	02/15/2001	Robert Anthony Luciano JR.	83336.1540	4032
66880 7590 07/30/2007 STEPTOE & JOHNSON, LLP 1330 CONNECTICUT AVENUE, NW WASHINGTON, DC 20036			EXAMINER YOO, JASSON H	
			ART UNIT 3714	PAPER NUMBER
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 09/788,162	<b>Applicant(s)</b> LUCIANO ET AL.	
	<b>Examiner</b> Jasson H. Yoo	<b>Art Unit</b> 3714	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 5/22/07.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 153-171 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 153-171 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 153 and 162 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The limitation of "a new promotional award that is not redeemable for free game play" is not supported by Applicant's specification. See MPEP 2173.05(i) for negative limitations. Applicant argues that the support for this limitation has been provided in the Specification. However the specification cited in Applicant's Argument in page 5, does not provide support for the limitations. For example, "the present invention also provides for very particularized forms of enhanced game play, enhanced game award levels, and enhanced general award levels that were not previously available" in Applicant specification page 13, lines 9-11, describe different game plays that are redeemable by the new promotional award. Page 40, lines 13-19 ("a primary difference between Newprom awards and award credits or game state savings is that in the preferred embodiment, Newprom awards are given to players based on non-gaming events and situations, meta-game events, as well as gaming events, can be used (depending on the specific Newprom award) for both enhancing

gaming and enhanced award distribution.") discloses how the new promotion award is awarded to the player, rather than describing how the promotional award is not redeemable by game play. Page 47, lines 8-10; p. 54, line 15-p. 55, line 19; p. 51, lines 8-10; p. 55, line 20-p. 56, line 9, discloses how the promotional award is redeemable for game play and does not disclose "the new promotional award is not redeemable by game play".

Claims 153 and 162 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The specification does not disclose how the new promotional award is not redeemable for free game play, wherein the new promotional award is configured to alter game play of at least one game. Applicant's Specification, page 47, lines 8-10; p. 54, line 15-p. 55, line 19; p. 51, lines 8-10; p. 55, line 20-p. 56, line 9, disclose how the promotional award is redeemable for game play, (i.e. redeemable to trigger a bonus game, wherein bonus games are considered to be a free game play). If game play is redeemed by credits such as promotional awards, then the game play is not free because promotional awards are used purchased the game play. Furthermore, Applicant has not clearly defined the terms "free game play". The closest terms to "free game play" cited in the Specification, are the terms "free play" as additional game credits (in Page 7.lines 4-5). However, Applicant has not clearly defined nor associated

free play with free game play. Applicant has also indicated new promotional awards are game credits (page 40, lines 4-6; page 47, lines 2-5 describes how the promotional game credits are used as a form of game currency). Due to the 35 US 112 issues, the claims will be examined based on the Examiner's best understanding of the claims.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 153-155, 157-165, 167-171 rejected under 35 U.S.C. 102(e) as being anticipated by Walker (US 6,227,972).

Walker discloses the following:

153, 162. A method for enhancing game play on a gaming machine, the method comprising:

providing at least one game on a gaming machine that is capable of receiving a new promotional award that is not redeemable for free game play (Player may receive a new promotional award by obtaining a prepaid card, cols. 4:61-5:9.), wherein the new

promotional award is configured to alter game play of at least one game, and wherein the new promotional award is given to a player to encourage game play on the gaming machine (the new promotional award configures the game play by allowing the player to play more games or wager more credits using the new promotional award, cols. 8:32-64, 10:26-11:14);

receiving the new promotional award from the player (player input that includes new promotional data is received in step 604 in Fig. 6A);

determining whether the new promotional award is applicable to at least one game on the gaming machine (determining if the satisfying conditions are met to access the balance, determining the awards are within the expiration period, determining if enough credits are available in the balance; step 710 in Fig. 7, cols. 3:47-65, 6:50-67:12, 8:1-9, 8:32-39, 10:5-61), wherein the new promotional award is configured to work on predetermined gaming machines (The new promotional award is inherently configured to work on predetermined gaming machines. Gaming machines must be configured to accept the new promotional award in order for the gaming machines to accept the new promotional award); and

reconfiguring, game play of the at least one game in response to the new promotional award (the new promotional award reconfigures the game play of at least one game by allowing the player wager more credits using the new promotional award, and thus the payout is inherently increased, cols. 8:32-64, 10:26-11:14);

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154, 164. The method of claim 153, wherein the new promotional award includes time restriction data having a predetermined, fixed expiration date for the new promotional award (cols. 2:55-3:2, 5:10-6:35).

155, 165. The method of claim 153, wherein the new promotional award includes location restriction data that restricts use of the new promotional award to a predetermined location or a predetermined set of locations (The promotional award or prepaid card is restricted to be used at the casino in which the prepaid card was received by the player, cols. 2:15-53, 3:3-46, 5:15-20).

157, 167. The method of claim 153, wherein reconfiguring the at least one game further comprises providing additional pay lines to the game, adding additional winning indicia to the game, triggering a secondary game, or any combination thereof (If the wager is increased using the new promotional award, the payout is inherently increased).

158, 168. The method of claim 153, wherein reconfiguring the at least one game further comprises providing a new pay table for the game in response to the new promotional award (A new pay table with higher payouts is provided if the wager is increased using the new promotional award.).

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159, 169. The method of claim 153, wherein reconfiguring the at least one game further comprises applying a multiplier to any winning outcomes of the game (when the wager is increased using the new promotional award, the jackpot is inherently multiplied by some factor to increase to jackpot. I.e. wagering one credit would provide a jackpot of \$1,000. If wagering two credits provide a jackpot of \$2,200, the jackpot is multiplied by a factor of 2.2).

160, 170. The method of claim 153, further comprising issuing a new promotional award to the player during a gaming session (issued to a player as part of a payout on a slot machine, cols. 4:61-5:9).

161, 171. The method of claim 153, further comprising issuing a new promotional award to the player at the conclusion of a gaming session (issued to a player when the payout is awarded, cols. 4:61-5:9).

163. The method of claim 162, wherein receiving player input further comprises:  
accepting player identification (col. 7:22-37); and  
retrieving new promotional data that is associated with the player identification (col. 7:38-57).



The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 156 and 166 are rejected under 35 U.S.C. 103(a) as being unpatentable over Walker' 972 (US 6,227,972) in view of Walker'765 (US 6,364,765).

156, 166. Walker'972 discloses the method of or enhancing game play on a gaming machine using promotional awards as discussed above. Walker'972 teaches the promotional awards are awarded to the players (col. 4:61-5:9) and to attract new customers and increase customer loyalty (col. 1:12-29). The promotional awards are also used to stimulate business in a casino during off-peak periods (col. 2:46-48). The casino can increase the customer loyalty with promotional awards and regulate the usage of promotional awards during off-peak periods by including restrictions such as an expiration time for the promotional awards, a time frame in which the players can use the promotional awards, or a minimum spending amount before the awards can be in effect (Figs. 5A-5B, col. 3:13-65). Furthermore, Walker'972 discloses slot machines that can receive player's information and determine if the player is within limits set by the restriction fields and use the promotional awards (step 616 Fig. 6A, col. 7:13-37, 7:59-8:9, 8:65-9:16). However, Walker'972 does not specifically teach the restriction of the new promotional award to a particular game, a set of related games, a family of

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games, or a predetermined subset of games. In an analogous art casino restrictions with awards Walker'765 discloses a method of playing a game where the casino restricts the usage to a particular game, a set of related games, a family of games, or a predetermined subset of games. Walker'765 discloses a secondary game played to play in specific slot machines or types of slot machines (cols. 7:3-815), in order for the casino operators to effectively utilize the valuable floor space of a casino. By encouraging player to move to higher profit machines or encouraging an idle player to play any machine, casinos can achieve a higher profit per machine. Directing slot players to particular machines also benefits players by enhancing or expanding their gaming experiences (col. 3:32-43). Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Walker'972's gaming method and incorporate a location restriction, restricting the usage to a particular game, a set of related games, a family of games, or a predetermined subset of games, in order to utilize the floor space of a casino and encourage players to move to higher profit machines.

### ***Response to Arguments***

Applicant's arguments filed 5/22/07 have been fully considered but they are not persuasive.

Regarding the claim rejection under 35 U.S.C. § 112 first paragraph, Applicant amended the previous limitation of "a new promotional award that is not redeemable for game play" to "not redeemable for free game play". However, Applicant's Specification

does not provide support for the limitation of "not redeemable for free game play."

Furthermore, Applicant's Specification does not disclose the enablement of using new promotional award for free game play that is not redeemable for free game play. See rejection above for details.

Regarding claims 153-171, Applicant argues that Walker'972 does not teach the limitation of new promotional award that is not redeemable for free game play. However as discussed above, the limitation contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention, and the limitation contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

### ***Conclusion***


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jasson H. Yoo whose telephone number is (571)272-5563. The examiner can normally be reached on 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Pezzuto can be reached on (571)272-6996. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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